REMARKS/ARGUMENTS

Claims 1-26 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. Interview Summary

On June 5, 2005, the Examiner and the undersigned attorney discussed the drawings and the rejections under 35 U.S.C. § 101. The Examiner stated that the drawings were acceptable. No agreement was reached regarding the rejections under 35 U.S.C. § 101.

II. Drawings

With regard to the drawings, the Examiner states that:

> The Examiner contends that the drawings submitted on July 31, 2003 are acceptable for examination proceedings, only. The drawings are difficult to read.

Office Action of March 8, 2006, p. 2.

The drawings presented with the application are formal drawings prepared by a professional draftsman. The drawings are clear. The drawings should be acceptable, as indicated by the Examiner during the Examiner interview.

III. 35 U.S.C. § 101

The Examiner rejected claims 1-26 under 35 U.S.C. § 101 as directed towards non-statutory subject matter. This rejection is respectfully traversed. The Examiner states that:

> 35 U.S.C. 101 reads as follows:
>
> > Whoever invents or discovers any new-and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.
>
> Claims 1-26 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete (See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).
>
> According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557) ... a specific machine to produce a useful, concrete, and tangible result (State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

> (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility m<http://rs6.net/tn.jsp?t=mdmd7pbab.O.kbq76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following: *Claim limitations describing* --

1. What is the practical application?

2. What is final result which Applicant considers concrete, useful and tangible?

> Because the "practical application, result, concrete, useful and tangible" limitations are not claimed in Applicant's claims, Examiner asserts that the above listed claims are nonstatutory.

Office Action of March 8, 2006, pp. 2-3 (emphasis in original).

Contrary to the Examiner's assertions, all claims comply with the standards presented in the MPEP and as required by *State Street*, *In re Lowry*, and *Warmerdam*. For example, claim 1 is as follows:

> 1. (Original) A method in a data processing system for managing an application's persistent data across multiple different release versions of said application, said method comprising the steps of:
> defining a format for a memory area wherein said persistent data will be stored according to a first release version of said application;
> organizing said format to permit said application running at different release versions to access said memory area; and
> accessing said memory area by said application that is running at a second release version utilizing said format.

Claim 1 is directed to a method *in a data processing system* for managing an application's persistent data across multiple different release versions. The method includes the steps of defining a format for a *memory area* and *accessing said memory area by said application*. Thus, claim 1 is directed to a method that creates a concrete and tangible result in a data processing system.

Furthermore, a memory area is a concrete and tangible aspect of a data processing system. Claim 1 contains features directed to manipulating the memory area. Therefore, again, claim 1 is directed to a method that creates a concrete and tangible result. Furthermore, by manipulating a memory area as claimed, functionally descriptive material is recorded on some computer-readable medium. According to the standards of *In re Lowry*, such a claim is statutory under 35 U.S.C. § 101.

Additionally, the Guidelines provide that:

> To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

> The claimed invention "transforms" an article or physical object to a different state or thing.
>
> The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Interim Guidelines of October 26, 2005, p.19. The Guidelines also provide that:

> *The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result.* Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

Interim Guidelines of October 26, 2005, pp. 20-21 (emphasis supplied).

Thus, the claims do not have to be tied to a particular machine or apparatus or operated to change articles or materials to a different state or thing. The only requirement is that the process claim must set forth a practical application to produce a real-world result. In the case of claim 1, the step of, "*accessing said memory area by said application* that is running at a second release version utilizing said format" provides a concrete result in a tangible object. A memory area is a tangible thing. Accessing the memory area is a tangible, real-world result. Accordingly, claim 1 meets the requirements of the Interim Guidelines with respect to patentability under 35 U.S.C. § 101. The same result occurs when the claims are compared to the underlying case law as when the claims are compared to the Guidelines.

Additionally, Applicants are under no requirement to recite *in the claims themselves* the purpose of the claimed invention. For example, the interim guidelines published by the PTO provide that:

> Accordingly, *a complete disclosure* should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Interim Guidelines of October 26, 2005, p. 4

The Guidelines provide that the *disclosure* should contain some indication of the practical application for the claimed invention. However, the practical application need not appear in the text of the claims. Instead, only features necessary to implement the practical application must appear in the text of the claims.

Regarding the other independent claims, claim 5 is directed to a method *in a data processing system* in which *memory areas* are logically subdivided. Claim 11 is directed to a *data processing system*

itself including a format for a *memory area* in which persistent data will be stored. Claim 15 is directed to *a data processing system* in which *memory areas* are logically subdivided. Claim 21 is directed to a computer program product *in a data processing system*. As explicitly provided in the case law and Guidelines cited above, such a claim is statutory under 35 U.S.C. § 101.

All of the independent claims contain features which make the claims statutory under 35 U.S.C. § 101, as provided by the Guidelines and the standards of accepted case law. Accordingly, the rejection of claims 1-26 under 35 U.S.C. § 101 is in error and should be withdrawn.

IV. 35 U.S.C. § 102, Anticipation

The Examiner rejected claims 1-2 under 35 U.S.C. § 102 as anticipated by *Nelson et al.*, Internet Presentation System, U.S. Patent Application Publication 2002/0174085 (November 21, 2002) (hereinafter *Nelson*). This rejection is respectfully traversed. The Examiner states that:

> Claims 1-2 are rejected under 35 U.S.C. 102 (e) as being anticipated by Nelson et al. (U.S. Pub. No. 20020174085A1 and Nelson hereinafter).
>
> Regarding Claim 1, Nelson teaches in a data processing system for managing an application's persistent data across multiple different release versions of said application, said method comprising the steps of: defining a format for a memory area wherein said persistent data will be stored according to a first release version of said application[00341 [0035]; organizing said format to permit said application running at different release versions to access said memory area[0039]; and accessing said memory area by said application that is running at a second release version utilizing said format[0009].

Office Action of March 8, 2006, pp. 4-5.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Applicants first address the rejection of claim 1. Claim 1 is as follows:

> 1. (Original) A method in a data processing system for managing an application's persistent data across multiple different release versions of said application, said method comprising the steps of:

defining a format for a memory area wherein said persistent data will be stored according to a first release version of said application;

organizing said format to permit said application running at different release versions to access said memory area; and

accessing said memory area by said application that is running at a second release version utilizing said format.

Nelson does not anticipate claim 1 because *Nelson* does not teach any of the claimed features. For example, *Nelson* does not teach the claimed feature of "defining a format for a memory area wherein said persistent data will be stored according to a first release version of said application." The Examiner asserts otherwise, citing *Nelson* as follows:

> [0034] In FIG. 2, a stand-alone projector, such as projector 11, is shown to incorporate a network interface component 37 for accessing the internet 21. Network interface 37 is coupled to a processing unit 31, which may be implemented as a CPU, FPGA, or any other data processing mechanism. As, shown, a stand-alone projector preferably includes an LCD panel 35 for providing a user interface. LCD panel 35 provides an access means for a user to interact directly with the projector, and indirectly with server 17 through the projector.
>
> [0035] Processing unit 31 is coupled to memory 33, which is divided into four functional sections 41-47. The functional sections 41-47 may be integrated into a single re-programmable, nonvolatile memory, such as a Flash memory. Alternatively, functional sections 41-47 may be divided into multiple memory modules: in which case it is preferable that at least sections 41 and 45 be reprogrammable, nonvolatile memories. Section 41 holds the driver, which controls the basic input/output functions for the projector. Preferably, this section would also hold the java engine used by processing unit 31 to run a slide player software. Section 43 holds the slide player software, and processing unit 31 uses this section to edit or run a presentation obtained from server 17. As explained earlier, section 41 is reprogrammable, nonvolatile memory, meaning that the driver information may be updated to provided added or smoother functionality to the projector. Therefore, each driver in section 41 is associated with a corresponding Driver ID, which is stored in section 45. Also, the projector maintains a Hardware ID identifying it for comparison with the aforementioned second record listing used by server 17 to authenticate a periphery device. All projectors 11-15 would incorporate a similar Hardware ID memory section.

Nelson, paragraphs 0034 and 0035.

This portion of *Nelson* teaches modifications to a projector in order to better produce an Internet-based presentation system. Specifically, *Nelson* teaches that the projector has a memory 33 which has four functional sections, one or more of which may be programmable. Each section serves a different purpose; for example, section 41 holds a driver, section 43 holds slide player software, section 45 holds a driver identification, and section 47 holds a hardware identification.

However, this portion of *Nelson* does not teach "*defining a format* for a memory area wherein said *persistent data* will be stored *according to a first release version of said application*," as claimed in claim 1. Nothing in *Nelson* teaches or implies this claimed feature. The fact that a memory section in *Nelson* can hold a driver and that the driver can be updated is not equivalent to this claimed feature. For example, nothing in *Nelson* teaches or suggests that persistent data related to the driver will be stored according to a first release version of the driver. Nothing in *Nelson* teaches or suggests that a format is defined for a memory area wherein the persistent data for the driver will be stored according to a first release version of the driver. Similarly, nothing in *Nelson* teaches or implies performing a similar activity with respect to the slide presentation software. Furthermore, *Nelson* does not teach elsewhere the above-described feature of claim 1.

In addition, *Nelson* does not teach the claimed feature of "organizing said format to permit said application running at different release versions to access said memory area." The Examiner asserts otherwise, citing *Nelson* as follows:

> [0039] Returning to FIG. 1, the user interface is similar for both periphery projectors 13 and 15, and for stand-alone projector 11. The following describes the software interface, and uses terms common to modern menu driven applications, such as "menu", "menu item", "dialog box", "tools", "icon", "Edit" option button, "click on", "OK" option button, "Next" link, "Previous" link, etc, and are considered within the understanding of a person versed in the art. The user's first task is to point his or her browser to the appropriate web site, i.e. server 17. From here, he or she may choose to navigate to the presentation utility area. The first page the user will see is the login page. After logging in, the user will see a list of all her presentations. From here, she can create a new presentation, edit an existing presentation, or delete a presentation. The user will also see how much space she has remaining on the server.

Nelson, paragraph 0039.

This portion of *Nelson* teaches a menu-driven user interface for software that controls the projectors. The user visits a website hosted by *Nelson*'s server and, on the website, navigates to a presentation utility area. After logging in, the user can see a list of all presentations that the user has prepared ahead of time. From there, the user can create a new presentation, edit an existing presentation, or delete a presentation. In other words, *Nelson* is describing a user interface for manipulating user-defined presentations that are stored on a server required in *Nelson*'s presentation system.

However, this portion of *Nelson* does not teach the claimed feature of "organizing *said format* to permit said application *running at different release versions to access said memory area*." This portion of *Nelson* does not teach or suggest organizing the format of a memory. This portion of *Nelson* does not teach or suggest organizing the format to permit an *application* running at *different release versions* to access the memory area. This portion of *Nelson* deals only with accessing user-defined presentations,

which has nothing to do with organizing a memory format to permit applications running at different release versions to access the memory area, as claimed. Similarly, nothing in *Nelson* teaches or suggests this claimed feature.

In addition, *Nelson* does not teach the claimed feature of "accessing said memory area by said application that is running at a second release version utilizing said format." The Examiner asserts otherwise, citing *Nelson* as follows:

> [0009] It is a further object of the present invention to remove the need to have a common application software, with a common version release, on all machines that are to run the present file.

Nelson, paragraph 0009.

This portion of *Nelson* asserts that *Nelson*'s system will obviate the requirement that the same software version must be run on two different machines in order to execute a file designed for use with the software. Thus, for example, *Nelson* asserts that a user can create a user-defined file on an *independent web server* using software stored *on the independent web server*, and then access and execute that user-defined file from any computer. The need for multiple machines carrying the same release version of software is obviated because *Nelson*'s web server maintains a single version of the software and also stores all of the presentation files.

However, this portion of *Nelson* does not teach the claimed feature of "accessing said memory area by said application *that is running at a second release version utilizing said format.*" Instead, on its face this portion of *Nelson* teaches only that no need exists to have a common release version on all machines that are to run the presentation file. However, *Nelson* does not teach that the technique he uses has anything to do with the claimed feature. Instead, *Nelson specifically avoids* running a second release version of an application by maintaining the software on an independent web server. Thus, *Nelson* specifically and directly contradicts the Examiner in this regard.

As shown above, *Nelson* does not teach any of the features of claim 1. For this reason, *Nelson* does not anticipate claim 1.

Regarding claim 2, the Examiner asserts that:

> Regarding Claim 2, Nelson teadches [sic] defining a format further comprising the step of logically dividing said memory area into individually accessible sections; and maintaining a template of a layout for each one of said sections for each one of said release versions [0035].

Office Action of March 8, 2006, p. 5. Claim 2 is as follows:

> 2. (Original) The method according to claim 1, further comprising the steps of:
>
> said step of defining a format further comprising the step of logically dividing said memory area into individually accessible sections; and

> maintaining a template of a layout for each one of said sections for each one of said release versions.

Nelson does not teach the claimed feature "maintaining a template of a layout for each one of said sections for each one of said release versions." The Examiner asserts otherwise, citing paragraph 35 of *Nelson*, which is cited above.

As explained above, *Nelson* teaches that the projector has a memory 33 which has four functional sections, one or more of which may be programmable. Each section serves a different purpose; for example, section 41 holds a driver, section 43 holds slide player software, section 45 holds a driver identification, and section 47 holds a hardware identification.

However, *Nelson* does not mention the word "template" in this paragraph. Elsewhere, *Nelson* only discusses "templates" in the context of user-defined files designed for use with presentation software. For example, *Nelson* teaches that:

> [0041] The user is now ready to edit the newly created presentation. The user should click on the "Edit" link for the desired presentation. This will show a presentation editor. For new presentations, a select slide template dialog box will appear so that the user can select a template for the first slide.

Nelson, paragraph 0041.

Thus, the "templates" that *Nelson* describes have nothing to do with the claimed "template of a *layout for each one of said sections for each one of said release versions*," as claimed in claim 2. Accordingly, nothing in *Nelson* teaches or suggests this feature of claim 2. For this reason, *Nelson* does not anticipate claim 2.

The Examiner does not assert that *Nelson* anticipates any other claims. The anticipation rejection of claims 1 and 2 has been overcome for the reasons presented above. Therefore, the anticipation rejections have been overcome.

V. Conclusion

It is respectfully urged that the subject application is patentable and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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